

## II. REMARKS

Claims 1-13 are currently pending in the present application. Claims 14 and 15 have been added. No new matter has been added.

### **Claim Rejections – 35 USC §102:**

Claims 1, 2, 5, 8, 9, and 12 are rejected under 35 USC §102(e) as being anticipated by Eichorst et al. (7,093,884). Claims 1, 3, 4, 7, 8, 10, and 11 are rejected under 35 USC §102(b) as being anticipated by Obendiek (2001/0040385).

For a rejection grounded in anticipation under §102 to be proper, every element and limitation recited in the rejected claim(s) must be found in the cited 102 reference. *See* MPEP §2131. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Id.*, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). *See also*, *In re Paulsen*, 30 F.3d 1475 (Fed. Cir. 1994). The MPEP restricts the prior art that may be cited by an Examiner in making a §102(b) rejection to those where the “identical invention [is] shown in as complete detail as is contained in the ... [rejected] claim.” *Id.*, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Independent claim 1 requires, in part, that “at least one drive element (8) is **arranged on** a holding device (9) that is configured to be mounted on the auto body and support at least one control unit (12), a hydraulic pump (16) and connections (14) of control lines (21) leading to drive units (4).” [emphasis added]. Independent claim 7 requires, in part, that “holding device (9) is designed as a **support for** at least one drive element (8) for a cover part (7) of a compartment top of a convertible vehicle (1).” [emphasis added]. Independent claim 8 requires, in part, “a holding device configured to be mounted to the vehicle body; and at least one drive element configured for moving said at least one movable cover part between said first and second positions, said at least one drive element being **arranged on** said holding device; wherein said holding device is further configured to support at least one control unit, a hydraulic pump, and connections of control lines leading to drive units for the roof movement.” [emphasis added].

The Examiner states that Eichorst et al. discloses “at least one drive element 50, wherein the drive element is **arranged on a holding device** (panel 42) mounted on the autobody and configured to support at least one control unit 46, a hydraulic pump 50, and connections to control lines (Figure 5).” [emphasis added]. Furthermore, the Examiner states that “[t]he cover part is configured to be moved by a single drive element 50.” The Examiner has indicated both the drive element and the hydraulic pump as element number 50. As the drive element and the hydraulic pump are two discrete components, it is the Applicants’ understanding that the Examiner actually intended the drive element to be element number 52.

While Eichorst et al. discloses a control unit 46, a hydraulic pump 50, and connections of control lines arranged on a holding device 42, Eichorst et al. fails to disclose or suggest a drive element that is **arranged on** the holding device 42. The drive element 52 is attached the autobody in spaced relationship to the holding device 42, as shown in Figure 5. Accordingly, claims 1 and 8 are not anticipated by Eichorst et al. and are allowable for at least this reason.

Claims 2 and 5, which depend from allowable claim 1, and claims 9 and 12, which depend from allowable claim 8, are also allowable for at least this reason.

The Examiner states that Obendiek discloses “at least one drive element (links) 18, 19, 24, 27, 28, characterized in that the drive element is **arranged on a holding device** 16 that can be mounted on the auto body, which is also a support for at least one control unit (links), a hydraulic pump 36, 38 and connections of control lines (Figure 5) leading to drive units for roof movement.” [emphasis added].

The Examiner has indicated that the drive element and the control unit are both the “links”. As the drive element 8 and the control unit 12 of the subject application are shown in Figure 4 to be two discrete components, the links cannot be both the drive element and the control unit. Furthermore, Obendiek teaches that the links movably interconnect the roof 4 and the holding device 16 in response to activation of a cylinder 36 and piston rod 38, as taught in paragraph [0046] and in Figures 1-3 and 5. The subject application teaches that the drive

element 8 and the control unit 12 are not links that are movably interconnected to the roof, as shown in Figure 4. Accordingly, claims 1, 7, and 8 are not anticipated by Obendiek and are allowable for at least this reason.

Claims 3 and 4, which depend from allowable claim 1, and claims 10 and 11, which depend from allowable claim 8, are also allowable for at least this reason.

**Claim Rejections – 35 USC §103:**

Claims 6 and 13 are rejected under 35 USC §103(a) as being unpatentable over Obendiek as applied above to claims 1 and 8 and in view of Graf (5,645,309).

Obviousness is a question of law based on factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). MPEP § 2141. The *Graham* factual inquiries include (A) determining the scope and content of the prior art; (B) ascertaining the differences between the claimed invention and the prior art; and (C) resolving the level of ordinary skill in the art. *Id.*

“Once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.” MPEP § 2141(III). According to MPEP §2142, “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (emphasis added). “[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” MPEP §2142 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

As recited by MPEP § 2141.02, “[a]scertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.” (emphasis added). “[T]he question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *Id.* (emphasis in original).

Fundamentally, to establish a prima facie case of obviousness of a claim, the references, after combination, must teach or suggest all the claim limitations (MPEP §2143).

As previously discussed for claims 1 and 8, Obendiek fails to teach a control device arranged on a holding device, as required by the subject application. Likewise, while Graf discloses a holding device 11 and a drive element 24 attached to the holding device 11, Graf also fails to teach a control device arranged on the holding device. Nor is it obvious based on the disclosure of Obendiek how Graf would be modified to provide these missing limitations.

Claim 6 ultimately depends from claim 1. Claim 13 ultimately depends from claim 9. For at least for these reasons, the rejection of Claims 2-5 and 12-15 under Section 103(a) is overcome.

**New Claims:**

Claims 14 and 15 are new. Support for claim 14 can be found at least in paragraph [0025] and Figures 4 and 5. Support for claim 15 can be found at least in paragraph [0022] and Figures 2-4. No new matter has been added.

### III. CONCLUSION

All rejections having been addressed, it is therefore respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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